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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/270,710	03/16/99	GLASER	L 0388-0020
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	EXAMINER
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ART UNIT	PAPER NUMBER

2166
DATE MAILED: 11/06/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SM

Office Action Summary

Application No.

09/270,710

Applicant

Glaser

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 22, 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

SAN DIMEL
REPLY SUMMIT
AN 2166

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DETAILED ACTION

1. Claims 1-22 are presented for examination. Applicant filed an amendment on 8/22/2001 amending claim 1 and adding claim 22. After careful consideration of Applicant's amendment and arguments, the Examiner finds Applicant's arguments to be nonpersuasive and the Examiner maintains the outstanding grounds of rejection of claims 1-21 as set forth in detail below.

Response to Arguments

2. Applicant's arguments filed 8/22/2001 have been fully considered but they are not persuasive.
3. With respect to claim 1, Applicant argued that the Goldschmitt reference does not explicitly disclose "associating a preselected advertisement with a communication within the data processing system associated with the sending party ...". The Examiner disagrees. As admitted by Applicant, Goldschmitt teaches the a message sent by a user 20 (i.e. sender) to center 18, then appending an advertisement to the message and transmitting the message when user 20 (i.e. the recipient) commands to read the message. The center 20 contains an email server 18 that is a data processing system that is associated with the sending party. Therefore, Goldschmitt discloses "associating a preselected advertisement with a communication within the data processing system associated with the sending party ..." and Applicant's argument is nonpersuasive.
4. With respect to claim 2, Applicant argued that Goldschmitt does not teach the step of offering the sender an option to become an advertiser and enabling, if the offer is accepted, a

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procedure within the data processing system by which the preselected advertisement is associated with the communication. The Examiner disagrees. As admitted by Applicant, Goldschmitt offers free email messaging. In order for a sender to use the Goldschmitt free emailing system, the sender accepts the Goldschmitt offer which includes appending an advertisement to sender's email. If the sender declines the offer, the user would presumably still be able to use email messaging for a fee as pointed out in Goldschmitt in the Background of the Invention section describing the existing prior art e mail systems . If the user accepts the offer of free email, the Goldschmitt system is activated and a preselected advertisement is attached to the email within the data processing system. Therefore, Applicant's argument is nonpersuasive.

5. With respect to claim 3, Applicant argued that Goldschmitt does not disclose the feature wherein the advertisement is associated with software or hardware operable with the data processing system. The Examiner disagrees. As discussed above, the email server 18 is a data processing system associated with the sender. As admitted by Applicant, the advertisement can be associated with the sponsor communication network, which is a part of the email server, and computer equipment (see Fig. 6) Therefore, Applicant's argument are not persuasive.

6. With respect to claims 4-6, 9, 15, 16, 18 and 19, Applicant argued that the argument to claim applies to claims 4, 5, 6, 9, 15, 16, 18, and 19. Since the Examiner found Applicant's arguments with respect to claim 1 to be nonpersuasive, the Examiner finds Applicant's arguments to claims 4-6, 9, 15, 16, 18 and 19 to be nonpersuasive for the same reasons as for claim 1.

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7. With respect to claims 7 and 14, Applicant's arguments are substantially similar to Applicant's arguments with respect to claim 1 and the Examiner refers Applicant to the discussion of arguments directed to claim 1 above. Therefore, Applicant's arguments are nonpersuasive.

8. With respect to claims 8, 10, 11, 12, 13, and 17, Applicant's argue that the arguments related to claims 1 and 2 are applicable to claims 8, 10, 11, 12, 13, and 17. Since the Examiner found Applicant's arguments directed to claims 1 and 2 to be nonpersuasive, the Examiner finds Applicant's arguments directed to claims 8, 10, 11, 12, 13, and 17 to be nonpersuasive for the same reasons.

9. With respect to claims 20-21, Applicant argues that Examiner's use of official notice in light of Goldschmitt does not disclose the features of claim 20. The Examiner disagrees. In order to further prosecution, the Examiner refers Applicant to previously cited Pat. No. 6,018,761, Uomini, as evidence that the Examiner's use of official notice was well known ant the time of Applicant's invention. Uomini discloses and electronic messaging system that attaches information to the mail messages (see abstract and col. 1, lines 8-10). The information is stored separately from the email message and the stored information is retrieved when the electronic message is read by the recipient (see col. 2, lines 56-67). In Uomini, a signature block (i.e. context data) is used to transmit information to the recipient and is attached to the sender's message(see col. 5, lines 6-18). The signature block may be stored at the email server (commercial context providing service might offer senders a storage location equivalent to repository 26 ...)(col. 5, lines 19-35). Therefore, the signature block may be stored at the email server which is a data processing system

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associated with the sender. Furthermore, Uomini disclose the signature block may contain business information (i.e. advertisement)(col. 5, lines 10-12). Therefore, Applicant's arguments directed to claim 20 are nonpersuasive.

10. With respect to claim 21, newly added claim 21 is directed to a new feature not previously presented in any of originally filed claims 1-21. Therefore, the Examiner refers the Applicant to the new grounds of rejection of claim 22 in the next section below.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/24213 A1, Goldschmitt et al. (hereinafter Goldschmitt) in view of "World Wide Watch" (hereinafter The Mail).

As per claim 1, Goldschmitt discloses a method of transmitting an advertisement from a sending party to a receiving party (see abstract and Fig. 4) comprising the steps of:

initiating a communication from a data processing system associated with the sending party (see Fig. 1 and page 8, line 26 - page 9, line 2);

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associating a preselected advertisement with said communication within the data processing system associated with the sending party (page 9, lines 8-13)

transmitting said communication with said preselected advertisement therein to the recipient (see abstract)

Goldschmitt does not explicitly disclose

embedding the advertisement within the communication.

However, The Mail discloses transmitting said communication with said preselected advertisement embedded therein to the recipient (i.e. inserting advertisements into user's e-mail messages)(see page 1, abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include embedding the advertisement within the communication within the Goldschmitt system in order to provide an alternative source of revenue (page 2, lines 29-33)

As per claim 2, Goldschmitt discloses the method of claim 1, further comprising the steps of: offering to the sender an option of becoming an advertiser (i.e. offer to provide free email service) and enabling, if the offer is accepted, a procedure within said data processing system by which said preselected advertisement is associated with the communication (see abstract).

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As per claim 3, Goldschmitt discloses the method of claim 1, wherein the advertisement is associated with at least one of software or hardware operable with the data processing system (i.e. email message or software)(see abstract).

As per claim 4, Goldschmitt discloses the method of claim 1, wherein the communication is at least one of e-mail, facsimile, voice-over-IP, voice-over-Internet, voice mail, video mail, video teleconferencing, and an animated presentation (i.e. email)(see abstract).

As per claim 5, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent for a preselected time period (i.e. between 5:00 PM and 7:00 PM)(page 6, lines 1-11.

As per claim 6, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent up to a pre-selected number of times)(i.e. certain number of times during the day)(page 6, lines 1-11).

As per claim 7, Goldschmitt discloses the method of claim 1, wherein said preselected advertisement is electronically obtained from a third party data processing system (i.e. advertiser storage data files unit 24)(see Fig. 1 and page 8, lines 14-15).

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As per claim 8, Goldschmitt discloses the method of claim 2, wherein the user is compensated for accepting the offer to become an advertiser (i.e. user receives free email)(see abstract).

As per claim 9, Goldschmitt discloses the method of claim 1, wherein the advertisement is at least one of visual and aural (i.e. graphics)(page 9, lines 23-29).

As per claim 10, Goldschmitt does not explicitly disclose the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware.

However, the Examiner takes official notice that it was well known to provide advertisements within setup software for software or hardware in the computer arts. The purpose was to alert the customer of other products owned by the manufacturer that might be of interest to the customer. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware within the Goldschmitt system for the motivation stated above.

As per claim 11, Goldschmitt discloses the method of claim 2, wherein means for sending the communication comprises at least one of an e-mail client, a facsimile system, a voice-over-IP

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system, a voice-over-Internet system, a voice mail system, a video mail client, and a video teleconferencing system (i.e. email)(see abstract).

As per claim 12, Goldschmitt discloses the method of claim 2, further comprising offering to a recipient of the communication and advertisement an option of being an advertiser (see abstract).

As per claim 13, Goldschmitt discloses the method of claim 12, wherein said step of offering to a recipient of the communication and advertisement an option of being an advertiser includes fraud avoidance means for reducing or eliminating fraud associated with the transaction (see abstract).

As per claim 14, Goldschmitt discloses the method of claim 7, wherein said preselected advertisement is electronically obtained from a third party data processing system using the Internet (page 8, lines 5-8).

As per claim 15, Goldschmitt discloses the method of claim 1, wherein the advertisement is displayed to a recipient during a period of at least one of before, during and after the communication (page 8, lines 10-13 and page 9, lines 1-7).

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As per claim 16, Goldschmitt discloses the method of claim 1, wherein the data processing system is at least one of a computer and telephone (see Fig. 1 and col. 8, lines 1-13).

As per claim 17, Goldschmitt discloses the method of claim 2, wherein the advertisement is embedded in the communication by a third party (i.e. email messaging center 18)(page 8, lines 14-25).

As per claim 18, Goldschmitt discloses the method of claim 1 wherein said preselected advertisement is determined at least in part by the recipient's demographic (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

As per claim 19, Goldschmitt discloses the method of claim 18 wherein said demographic is at least one of location, language, gender, age, income, and physical handicap (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

As per claim 20, Goldschmitt discloses a method of transmitting an electronic communication including an advertisement from a data processing system associated with a sending party to a data processing system associated with a receiving party (see abstract) comprising the steps of:

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transmitting an electronic communication using the data processing system associated with the sending party to the data processing system associated with the recipient (see abstract).

Goldschmitt does not explicitly disclose

locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the data processing system associated with the sending party;

modifying information stored within said signature file to include an advertisement; and said electronic communication including said information stored within said signature file including said advertisement.

However, the Examiner takes official notice that it was old and well known to include signature blocks within email messages. The purpose of a signature block was to personalize the email message without requiring the user to write their personalized signature for each email message. In addition, the Examiner takes official was old and well known to incorporate graphics and html links within signature blocks. The purpose was to draw the recipient's attention to information in the signature block. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the data processing system associated with the sending party, modifying information stored within said signature file to include an advertisement and said electronic communication including said information stored within said

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signature file including said advertisement within the Goldschmitt system for the motivation stated above.

As per claim 21, Goldschmitt does not explicitly disclose the method of claim 20 wherein said signature file is associated with an e-mail client operating on said data processing system associated with the sending party.

However, Goldschmitt discloses attaching preselected advertisements to an email message of a recipient wherein said preselected advertisement is electronically obtained from a third party data processing system (page 8, lines 5-8). Embedding the advertisements within a signature file at the third party data processing system permits the system to add advertisements to the portion of the email message that is always present thereby simplifying the efficiency and cost of the system. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 20 wherein said signature file is associated with an e-mail client operating on said data processing system associated with the sending party within the Goldschmitt system for the motivation stated above.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt and The Mail as applied to claim 1 above, and further in view of Uomini, Pat. No. 6,018,761.

As per claim 22, Goldschmitt and The Mail do not explicitly disclose the method of claim 1 where associating said preselected advertisement with said communication further comprises

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associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement.

However, Uomini discloses associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement (see Fig. 2b and 2c). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement within the Goldschmitt and The Mail combination in order for the recipient to obtain message context information regardless of whether it is provided or not by the sender (col. 1, lines 8-10 and col. 2, lines 56-67).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. JP10320314A discloses a system that automatically inserts an advertisement into electronic mail.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

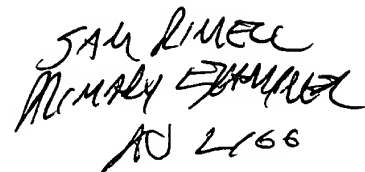
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski



11/3/01



JAN RINEE
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